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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,502	12/10/2004	Hidekuni Morakami	52433/781	1252
26646 7590 09/03/2009 KENYON & KENYON LLP ONE BROADWAY NEW YORK, NY 10004				
EXAMINER YEE, DEBORAH				
ART UNIT		PAPER NUMBER		
1793				
MAIL DATE		DELIVERY MODE		
09/03/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/517,502

Applicant(s)

MURAKAMI ET AL.

Examiner

Deborah Yee

Art Unit

1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-11 is/are pending in the application.
- 4a) Of the above claim(s) 7-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10 and 11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 14, 2009 has been entered.

Election/Restrictions

2. Claims 7 to 9 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on July 27, 2007.

Claim Objections

3. Claim 10 is objected to because of the following informalities: The recitation "the amount of N existing as BN)/ (the amount of N existing as AIN) is at least 0.50" has a typo-error wherein "at least 0.50" should instead be ≥ 10.0 . Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. There is no antecedent basis in the preamble of claim for "steel sheet comprises nickel plating on the steel and beneath the enameling". It is recommended to use language such as --A nickel plated enameled steel sheet made with a steel sheet...-- at preamble and ---and whereby steel sheet is nickel plated beneath the enameling in an amount of about 0.01 to 2 g/m²---at last 2 lines.

Double Patenting

7. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

8. Claims 10 and 11 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 to 3 of U.S. Patent No. 6,808,678 in view of English abstract of JP360100686 ("JP'686") or English abstract of Japanese patent 73029289 ("JP'289").
9. U.S. patented claims disclose steel plate for enameling having the same composition with overlap in nitride size limitations to pending claims; and such overlap establishes a prima facie case of obviousness.

10. Even though U.S. patented claims do not recite nickel plating steel sheet beneath the enameling in an amount of about 0.01 to 2 g/m² as in pending claims, such limitation would be obvious to incorporate since it is common practice in the metallurgical art to nickel plate steel sheet prior to enameling in an amount of 0.02 to 2.5 g/m² thickness to achieve excellent enameling adhesion as evident by the English abstract of JP-289 and JP-686.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over machine English translation of Japanese patent 2002-80934 (hereinafter JP'934) in view of English abstract of JP360100686 ("JP'686") or English abstract of Japanese patent 73029289 ("JP'289").

13. JP'934 in Table 2 on page 6 discloses steel plate examples for enameling having compositions that meet claims 10 and 11.

14. JP-934 teaches steel having (nitrogen present as BN)/ (nitrogen present as Al) being not less than 10 which meets claim 10.

15. JP'934 teaches controlling the size distribution of BN for improving the anti-aging property and the anti-seed and anti-black-speck properties such that the average diameter of precipitates of BN alone and BN-containing composite precipitates having a

diameter of not less than 0.005 μm and not more than 0.5 μm is limited to not less than 0.010 μm and the proportion of the number of precipitates having a diameter of not more than 0.010 μm in the number of precipitates of BN alone or BN-containing composite precipitates having a diameter of not less than 0.005 μm and not more than 0.5 μm is limited to not more than 10%. Similarly present invention teaches controlling nitride limitation wherein "simple or compound nitrides having a diameter of 0.02 to 0.50 μm which contain B or Al, and having the average diameter of 0.08 μm or larger, and the proportion of the number of the nitrides of 0.050 μm or smaller in diameter to the total number of said nitrides being less than 10% recited in claim 10. Because nitride limitations of prior art and present invention are overlapping, then a prima facie case of obviousness is established because it would be obvious for one skilled in the art to select the claimed ranges over the broader disclosure of the prior art since the prior art teaches the same utility and properties, see MPEP 2144.05.

16. Even though JP'934 does not teach nickel plating steel sheet beneath the enameling in an amount of about 0.01 to 2 g/m^2 as recited by claims, such limitation would be obvious to incorporate since it is common practice in the metallurgical art to nickel plate steel sheet prior to enameling in an amount of 0.02 to 2.5 g/m^2 thickness to achieve excellent enameling adhesion as evident by the English abstract of JP-289 and JP-686.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah Yee whose telephone number is 571-272-1253. The examiner can normally be reached on monday-friday 6:00 am-2:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on 571-272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Deborah Yee/
Primary Examiner
Art Unit 1793

/DY/